

Remarks

Claims 1-5, 9-19 remain pending. Claims 1, 5, and 12 have been amended.

Claim Amendments

Applicant has amended claims 1 and 12 to correct the typographical errors identified by the Examiner. Specifically, the word "channel" following "list of potential" has been replaced with the word "channels" as suggested by the Examiner. Applicant requests withdrawal of the objections to claims for informalities.

Applicant has also taken this opportunity to correct a typographical error in claim 5. The second occurrence of the definite article "the" has been deleted.

Claim Rejections – 35 USC 103

The Examiner rejected claims 1-9 and 12-19 as being unpatentable over U.S. Patent No. 6,393,284 to Dent in view of U.S. Patent 6,052,590 to Hicks et al. The Examiner rejected claim 10 as being unpatentable over the combination of Dent and Hicks et al, and in further view if U.S. Patent 5,465,388 to Zicker. The Examiner also rejected claim 11 as being unpatentable over Dent and Hick et al, and in further view of U.S. Patent 5,258,981 to Davey et al. Applicant respectfully disagrees.

The Examiner has not made a *prima facie* case for rejection under section 103 because the references fail to disclose or suggest all claim elements.

Independent claims 1 and 12

Applicant Dent and Hicks et al, either alone or in combination, fail to teach all the elements of independent claims 1 and 12. In particular, the cited references neither disclose nor suggest scanning "one or more other subsets of the associated channels" to assemble "a complete list of potential channels having a power in excess of the predetermined threshold" upon identifying at least one channel in the list of potential channels as carrying the encoded signal, as recited in independent claims 1 and 12.

To make a *prima facie* case under section 103, the Examiner's burden includes (but is not limited to) citing references that teach or suggest all of the features of a claimed invention. E.g., *In re Ochial*, 71 F.3d 1565, 1572 (Fed. Cir. 1995); *In re Wada and Murphy*, Appeal No. 2007-3733, slip op. at 7 (BPAI 2008). If the references fail to teach or suggest one or more elements, the Examiner's *prima facie* case is flawed for failing to meet this legal standard.

Dent does not teach or suggest scanning "one or more other subsets of the associated channels" to assemble "a complete list of potential channels having a power in excess of the predetermined threshold" upon identifying at least one channel in the list of potential channels as carrying the encoded signal, as recited in independent claims 1 and 12. The Examiner previously conceded that Dent does not teach or suggest the above-noted features (refer to telephone interview on August 14, 2009, and Response dated September 22, 2009). See also, Office Action dated December 28, 2009, at page 4 for additional deficiencies of Dent noted by the Examiner.

Hicks et al do not teach or suggest these features either. According to the Examiner, Hicks et al teach "to create a list of potential channels carrying having power in excess of a predetermined threshold (sub-band is [s]canned to identify two strongest channels, which are checked in order against a pre-determined threshold; if the service provider of the channel is unacceptable, the mobile unit stores the channel number [fig. 3, col. 4, line 59-65, col. 5, lines 30-48] wherein multiple channels are scanned that exceed a first RSS threshold reads on 'to create a list' (see Office Action dated December 28, 2009 at page 4, emphasis in original).

Applicant respectfully submits that merely scanning multiple channels is the not same as "creating a list of potential channels" as claimed in claims 1 and 12.

Moreover, the cited passages of Hick et al teach that "if the service provider is from that 'unacceptable' class, the mobile unit stores the channel number, ends the channel band scan, and returns to the invoking procedure" (see Hicks et al at col. 5, lines 45-48, emphasis added). Hicks et al, at best, creates a list of unacceptable channels. A list of unacceptable channels is not the same as a list of potential channels carrying signals having power in excess of a predetermined threshold, as recited in claims 1 and 12. In fact, it is quite the contrary.

The Examiner further stated that Hick et al teach "scanning one or more subsets of the associated channels, which together with the selected subset of the associated channels comprise the predefined frequency band" and cited Fig. 3 and the corresponding description at col. 5, lines 30-42 in support of her assertion.

Applicant respectfully disagrees that Hicks et al teaches scanning additional subsets upon identifying at least one channel in the list of potential channels as carrying the encoded signal, as recited in claims 1 and 12.

On the contrary, Figs. 3 and 4 and the associated description in Hick et al, teach scanning the next or additional sub-bands only if it is determined that the signal strength of a channel is below the RSS threshold and if no other channel exists in the selected sub-band (see decision box 120 in Figs. 3 and 4 of Hicks et al). Hicks et al do not teach or suggest "upon identifying at least one channel in the list of potential scanning "one or more other subsets of the associated channels" to assemble "a complete list of potential channels having a power in excess of the predetermined threshold" upon identifying at least one channel in the list of potential channels as carrying the encoded signal, as recited in independent claims 1 and 12.

As previously submitted, independent claims 1 and 12 recite that when a selected subset of associated channels in a predefined frequency band is scanned to create a list of potential channels carrying signals having power in excess of a predetermined threshold and when at least one channel in the list of potential channels is identified as carrying an encoded signal; the remaining subsets of the associated channels, which together with the selected subset comprise the predefined frequency band, are then scanned to create a complete list of potential channels that carry the encoded signal. A connection between the mobile device and the network is established using the channel carrying the strongest signal within the channels identified as carrying the encoded signal.

Ordinarily, a device connects to the encoded signal carrying channel that has highest signal power. In the case where only a subset of the channels of the frequency band are scanned to find one or more channels carrying an encoded signal, one cannot be sure that any of said encoded signal carrying channels actually has the highest signal power of the possible channels in the complete set because channels of other subsets have not been scanned (at

that time). Thus, the claimed method and device ensure that having identified, in one subset of associated channels, at least one encoded signal carrying channel having power in excess of a predetermined threshold, a complete scan of all channels is performed to identify all encoded signal carrying channels to create a complete list of potential channels. From the complete list of potential channels, the encoded signal carrying channel having the highest power is then identified and a connection between the mobile device and the network is established with that channel. The complete scan is performed by either scanning all channels of the frequency band including the already scanned subset or just scanning unscanned subsets in addition to the scanned subset.

This arrangement has the advantage that, when no signal is detected, only subsets of the frequency band are scanned thereby saving battery power. However, when a signal is detected during a scan of a subset of the channels, this provides an indication that it would now be a good time to perform a full scan to obtain a complete list of channels having an encoded signal. Thus, the present invention saves power through scanning only subsets of channels when no signal is detected but when a signal is detected during a scan of a subset of channels, a full scan is performed so that the connection is established using the channel with the highest power that carries the encoded signal (providing for example, better reliability of the connection, etc). Dent and Hicks et al do not teach or suggest full scanning if an encoded signal is detected during a scan of a subset of channels.

Clearly, Dent and Hicks et al do not teach or suggest each and every feature as recited in independent claims 1 and 12. Consequently, independent claims 1 and 12 are not obvious in light of Dent and Hicks et al. For at least the same reasons, their respective dependent claims are patentable over Dent, Hicks et al, Zicker and Davey et al. Withdrawal of the rejections under 35 USC 103 is respectfully requested.

Applicant submits that the Examiner's rejections have been addressed and cordially requests early reconsideration of this application.

The Commissioner is hereby authorized to charge any additional fees, and credit any over payments to Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP.

Respectfully submitted,

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